

REMARKS

In the January 16, 2004 Office Action, claims 1-4, 11-16, 21, 26, and 29 have been rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,324,922 to Roberts (“the ‘922 patent”). The ‘922 patent generally teaches a system for managing transactions that uses a barcode reader connected to a transaction terminal to read barcodes from a specialized catalog. The rejected claims have either been cancelled or amended herein in order to more clearly reflect the present invention. The claims in their amended form recite several elements not disclosed or suggested by the ‘922 patent and are therefore allowable over the reference.

For example, amended claim 1 recites a method for automated shopping including the steps of placing a cordless handheld scanning wand in a vendor mode by activating a vendor mode button on the scanning wand, placing the cordless handheld scanning wand in a user mode by activating a user mode button on the scanning wand, and placing the cordless handheld scanning wand in a product mode by activating a product mode button on the scanning wand. Amended claim 1 further recites connecting the cordless handheld scanning wand to the order center over the data network by placing the cordless scanning wand in a cradle module connected to the data network.

The ‘922 patent fails to teach or suggest any of these recited elements. For example, the barcode reader 21 taught by the ‘922 patent is not cordless but is instead connected by a cable to transaction terminal 10 (see e.g., the ‘922 patent, Fig. 1). The transaction terminal 10 is connected to the public telephone network 30. *Id.* Accordingly, the ‘922 patent teaches a more cumbersome and less portable method than is claimed by amended claim 1. Additionally, the ‘922 patent fails to teach activation of any buttons located on the barcode reader. For these and other reasons, amended claim 1 is allowable over the ‘922 reference. Claims 2, 3, and 4 depend from claim 1 and are allowable over the ‘922 patent for the same reasons as are that claim. In addition, claim 4 provides further details regarding method steps of using the buttons located on the scanning wand that are not taught by the ‘922 patent.

Claim 11 has been canceled herein. Claim 12 depends from claim 1 and further recites steps of using a scanning wand that includes vendor mode indicator means, user mode indicator means, and product mode indicator means. The '922 patent fails to teach using a scanning wand that includes these indicator means. Claim 13 depends from claim 12 and further recites that the various indicator means comprise indicator lights on the scanning wand. Claims 12 and 13 are therefore allowable over the '922 patent. Claims 14-16 depend from claim 1 and are allowable over the reference for the same reasons as are that claim.

Claim 21 depends from claim 1 and is also allowable over the '922 patent for the same reasons that claim 1 is. Additionally, claim 21 further recites that the cordless handheld scanning wand has an order status button in addition to a step of activating the order status button to transmit an order status request to the order center. These recited elements are not taught or suggested by the '922 patent with the result that amended claim 21 is allowable. Claims 26 and 29 have been canceled herein.

The January 16 Office Action has also rejected claims 5-10, 17-20, 22-25, 27-28, and 30 under 35 U.S.C. §103(a) as obvious over the '922 patent in view of U.S. Patent No. 6,308,893 to Waxelbaum ("the '893 patent"). The '893 patent generally teaches a compact optical code reader capable of performing functions including reading bar codes for use in sales transactions. Some of the rejected claims have been cancelled herein. All remaining of the rejected claims have been amended in order to more clearly reflect the present invention, and in their amended form are not obvious over the '922 patent in view of the '893 patent.

Claim 5 has been canceled herein. Claims 6 and 7 depend from claim 1 which recites numerous elements not disclosed or suggested by one or both of the '922 and the '893 patents, and is therefore allowable over the references. For example, neither of the '922 or '893 patents disclose or suggest activating of a user mode button, a product mode button, or a vendor mode button located on a scanning wand that are recited by claim 1. Although the '893 patent discloses a cordless optical code reader, it does not

include the recited buttons. Instead, only a single scan button 36 and delete button 38 are taught (see the '893 patent, col. 5, lines 48-52). Amended claims 6 and 7 are therefore allowable. Claims 8 and 9 have been canceled herein. Claim 10 depends from claim 1 and is allowable over the cited references for the same reasons as are that claim. Claims 17-20 have been canceled herein.

Claim 22 recites several steps not disclosed or suggested by the '922 or '893 patent. For example, amended claim 22 recites steps of activating a vendor mode switch means and activation of a vendor mode indicator display both located on the wand, activating a user mode switch means and activation of a user mode indicator display located on the wand, and activating a product mode switch means and activation of a product mode display located on the wand. Amended claim 22 further recites steps of reading a catalog title and a mailing label from the catalog with the scanning wand. These steps are not disclosed by either of the cited references that instead depend on reading barcodes from specially provided documents. Claims 23 and 24 have been canceled herein. As amended, claim 25 recites numerous elements including activation of various mode buttons causing illumination of mode indicator lights located on the wand that are not suggested or disclosed by the cited references. For this and other reasons, claim 25 is allowable.

Claims 27 and 28 have been canceled herein, and claim 30 has been amended to more clearly reflect the present invention. As amended, claim 30 recites a computer program product that causes a handheld scanning wand to enter into various modes upon activation of mode buttons located on the wand and to cause corresponding mode indicator lights located on the wand to be illuminated. As discussed above, neither the '922 or the '893 patents disclose or suggest these recited elements. Claim 30 is therefore allowable.

Several new claims have been presented herein for consideration and are sincerely believed to be allowable. New claim 31 depends from claim 1 and further recites a plurality of vendor mode indicator lights located on the scanning wand that are

illuminated upon activation of corresponding mode buttons. New claim 32 depends from claim 1 and recites that the step of reading the machine-readable user identity code of claim 1 comprises reading a catalog mailing label with the scanning wand. This step is not taught or suggested by either of the cited references, which instead rely upon reading specialized barcode data fields provided on a specialized document. New claim 32 therefore recites an advantageous method that avoids the costs of producing specialized documents and catalogs with specialized barcode data fields. Claim 33 depends from claim 32 and further recites that address data is read from the catalog mailing label. New claim 34 depends from claim 1 and recites the step of reading the machine readable vendor identity code comprises reading a catalog name from a catalog cover. Finally, claim 35 recites the step of reading the machine readable product identity code comprises reading an alphanumeric product code with the scanning wand. Claims 33-35 are allowable over the cited references for the same reasons as have been discussed with regard to claim 32.

New claim 36 depends from claim 1 and further recites that first and second product identity codes corresponding to first and second vendor identity codes are read, stored in the transaction file, and communicated to the order center. New claim 36 further recites that the first product identity code is communicated along with the user identity code to a first vendor that corresponds to the first vendor identity code and the second product identity code that is communicated along with the user identity code to a second vendor corresponding to the second vendor identity code. Neither of the '922 patent or the '893 patent discloses or suggests transaction files that contain multiple products from multiple vendors much less the particular steps recited. New claim 36 is therefore allowable.

In response to the January 16, 2004 Office Action, several claims have been cancelled, others amended, and several new claims presented. It is sincerely believed that all remaining claims in their current form are allowable. Timely allowance is requested.

Should the Examiner feel that there are issues remaining for attention before allowance can be granted, the favor of a telephone conference with Applicant's undersigned Attorney is respectfully requested.

Respectfully submitted,

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